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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566
530	7590	09/08/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,232

Applicant(s)

TENENBAUM, SAMUEL SERGIO

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 58-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 58-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 5/2/05.

Response to Amendment

2. The amendment filed 5/2/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the language added to the claims regarding a lack of code present before the character is introduced cannot be found in the specification. The specification describes use of Flash which is believed to require pre-existing code in the form of a plug in. Applicant states that the alternative embodiment using GIF and WAV requires no pre-existing code, however no such disclosure regarding any such lack of code is set forth in the specification. In fact, a browser capable of natively processing GIF and WAV objects would still represent executable code present before animation was introduced. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-52 and 58-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Each independent claim calls for a lack of any code present before a character is introduced. This is believed to conflict with all disclosed embodiments. The browser needed to render the animation is clearly "code" that is present before the animation is introduced. Any flash functionality apparently requires a plug-in which is "present" before animation is introduced. Further, even when the animation is provided by GIF and WAV files, the browser (even if capable of processing those files without any "plug-in") includes coded functionality in order to properly render the GIF and WAV objects.
- Claims 3-11, 15-20, 25-34, 36, 42, 44, 49, 58, 59, 63-65 are rejected because it is not clear how the disclosure describes providing the multilayered animation features without Flash which is apparently an embodiment deliberately avoided by the claim language of "without the use of any executable code present before its introduction and dedicated to its production."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9, 21, 23-28, 34-40, 46, 48-52, 58-66 are rejected under 35

U.S.C. 102(b) as being anticipated by Gever et al (WO 97/35280).

As best understood regarding claims 1-5, 9, 23-27, 34-36, 40, 48, 49, 58, 59, 63-66, Gever et al (WO 97/35280) teaches the steps, system and programming to provide an animated character travel (translationally) across the user's screen in the form of an advertisement [abstract, 4:5-11, 7:1-15, 32:29-3136:11-13, figs 2, 6A]. The character is provided intrusively, out of the user's control as a transparent layer on top of the background content (such as a web page in an HTML-compliant browser). The area not covered by the character layer is visible through the transparency mask. Gever et al (WO 97/35280) teaches that the character may include audio such as reading displayed text (synchronized sound) – such is taken to provide a multimedia character [7:8-10]. Applicant's preamble and other language that mentions the environment of the operating system, computer system, application program and language, etc does not positively provide steps to be taken or system structure and therefore these are not taken as positive limitations. The environment in which a series of steps are performed does not define the steps themselves, for example. Further regarding claim 9, Gever et al (WO 97/35280) teaches that the animation files can be provided as VMRL, JAVA or HTML or in another standard file format recognized by suitable browsers [10: 1-5]. As best understood regarding the language that the character is introduced without use of executable code present before its introduction, Gever et al's (WO 97/35280) teaching

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that the animation can be provided via HTML (or in another standard file format recognized by suitable browsers) is an indication that no extra code need be present before introduction – the HTML is provided in the requested document rather than in the browser or a standalone supporting program. Further, Gever et al (WO 97/35280) teaches that the scene manager can be a standalone program – this indicates that there is no extra code present in the browser needed to render the animation. And in the case where the scene manager functionality is provided as a plug-in, no external, standalone manager code need be present.

Regarding claims 6-8, 28, 37-39, 46, 50-52, 60-62, Gever et al (WO 97/35280) teaches that the characters are defined as smart objects which are defined by parameters that determine their behavior; such stored parameters are taken to be stored in a server-accessible database [5:29-37, 6:1-17]. The client's PC communicates with the server in order to request and negotiate/authorize display of the animations. This communication is taken to meet the "exchange of information" language. The client PC inherently cannot display/control the animation if the PC lacks a minimum of video display capabilities, for example. The communication/exchange is taken to be interactive and results in determination of a sequence of commands to deliver that control the animation aspects.

Regarding claim 21, Gever et al (WO 97/35280) teaches that a sender may deliver an email message with an animation file included [10:23-27]. The animation files define the character behavior. The server signal which will call a page language does not provide any positive steps beyond a signal. Steps for calling of a page and

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displaying after completion of the message are not set forth positively. Nonetheless, the server which delivers the email inherently defines a background in the case of an HTML-based email message which remains until the user closes the message.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 10-12, 14-20, 29-33, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835).**

Regarding claims 10, 12, 14-18, 29-32, 41-45, Gever et al (US6313835) teaches that such animations can be programmed by an advertiser and triggered to display upon the user visiting a particular webpage. An animation ad is then chosen for the user based upon the user's profile and delivered and displayed for the user in his browser. It would have been obvious to one of ordinary skill at the time of the invention to have provided tags in particular webpages that enabled the system to recognize an advertising opportunity and to trigger the selection, delivery and display of the animation advertising character. The example of a user browsing Yahoo [WO fig 6A] while receiving an animation provides an example of content from a content server and animation from the system server of Gever et al (WO 97/35280).

Regarding claims 11, 33, Gever et al Gever et al (WO 97/35280) teaches that the animation display capability can be provided as part of a browser plug-in. It would have been obvious to one of ordinary skill at the time of the invention to have delivered the animation file as well as the plug-in installation file so the user can view the animation upon installation of the plug-in.

Regarding claims 19, 20, 47, Official Notice is taken that it is well known to use cookies to track and deliver user profile information, browsing history and preferences, etc and it would have been obvious to one of ordinary skill at the time of the invention to have used such cookies to target the animation selection and control of Gever et al (WO 97/35280).

8. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835) and Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of impressions and the duration of ad display. It would have been obvious to one of ordinary skill at the time of the invention to have tracked such information and paid the advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

9. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of

impressions and the duration of ad display. It would have been obvious to one of ordinary skill at the time of the invention to have tracked such information and paid the advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

10. Claims 1-9, 21, 23-28, 34-40, 46, 48-52, 58-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Gever et al (WO 97/35280) in view Apperly (macromedia.flash newsgroup – 1998/06/26 Re: FLASH to be included with NETSCAPE...).

As best understood, applicant is apparently attempting to claim that no browser plug-in or external supporting program is needed for the animation. Apperly (macromedia.flash newsgroup) teaches that it is known for browser makers such as Netscape and Microsoft to bundle third party player applications into the browsers themselves, eliminating the need to install plug-ins for specific browser functionalities. It would have been obvious to one of ordinary skill at the time of the invention to have bundled Gever et al's (WO 97/35280) scene manager program into the browser itself so that users of Gever et al's (WO 97/35280) system do not have to acquire and install the plug-in or external program.

11. Claims 10-12, 14-20, 29-33, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835) and Apperly (macromedia.flash newsgroup).

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It would have been obvious to one of ordinary skill at the time of the invention to have bundled Gever et al's (WO 97/35280) scene manager program into the browser itself so that users of Gever et al's (WO 97/35280) system do not have to acquire and install the plug-in or external program.

12. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835), Middleton et al (WO 99/13423) and Apperly (macromedia.flash newsgroup).** It would have been obvious to one of ordinary skill at the time of the invention to have bundled Gever et al's (WO 97/35280) scene manager program into the browser itself so that users of Gever et al's (WO 97/35280) system do not have to acquire and install the plug-in or external program.

13. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Middleton et al (WO 99/13423) and Apperly (macromedia.flash newsgroup).** It would have been obvious to one of ordinary skill at the time of the invention to have bundled Gever et al's (WO 97/35280) scene manager program into the browser itself so that users of Gever et al's (WO 97/35280) system do not have to acquire and install the plug-in or external program.

Response to Arguments

Applicant argues that Gever et al (WO 97/35280) requires a scene manager that must be installed by the user. Applicant's claim language is quite different from the arguments set forth. As pointed out, applicant is required to have pre-existing "code" such as the browser capable of rendering the objects, even if simply relying on a browser than natively handles GIF and WAV. As stated above, the teaching for the animation to be provided by HTML is taken as not requiring a plug-in or external program. Further, there is no requirement where no code must be present. An external helper program allows animation without "code" in the browser. A browser with a plug-in allows animation with no code present in an external program. A browser with a pre-bundled program otherwise required as a plug-in requires no "extra" code to be installed by the user. The "dedicated to its production" language cannot serve to limit the reasoning for the existence of code.

Applicant argues that a 2/24/05 article describes the desirability and commercial success of such floater ads. This argument has no weight for the repeated 102 anticipatory rejections. Further, the article appears to describe the benefits for any type of floater ad, including the Gever floating ads which pre-date applicant's earliest filing date.

Applicant argues that Gever et al (WO 97/35280) teaches away by providing the ability for a user to exercise substantial control of the character. Examiner believes that while some control can be had, some embodiments lack ability for user control and therefore Gever et al does not teach away.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc